

Amendment/Response

Reply to Office Action of January 5, 2006

IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the USPTO using EFS-Web on June 5, 2006 by Christopher R. Pastel.



Appl. No. : 10/076,578
Applicant(s) : Luciano III, Frank J.
Filed : 02/13/2002
Title : NET-AWARE TELEPHONE SWITCH
TC/A.U. : 2661
Examiner : Phunkulh, Bob A.
Atty. Docket : CN920010005US1

DECLARATION UNDER 37 CFR 1.131

I, Frank J. Luciano, do declare that I acknowledge that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. § 1001) and may jeopardize the validity of the application or any patent issuing thereon. All statements made of my own knowledge are true and all statements made on information and belief are believed to be true.

I am the inventor of the invention described in U.S. Application Serial No. 10/076,578 entitled NET-AWARE TELEPHONE SWITCH which was filed on February 13, 2002.

I am employed by the IBM Corporation, and was so employed during the conception of this invention.

I was temporarily working in Beijing, China from July 1997 through January 2004.

I created this invention on January 1, 2001 and documented the invention using Lotus Freelance. The documents I filed in Lotus Freelance are attached as Exhibit A.

I submitted an invention disclosure to IBM on January 15, 2001, part of which is attached as Exhibit B. Note that pages 2 and 3 of Exhibit B are the same drawings as those in Exhibit A. Exhibit D attached herein is the complete automated invention disclosure form which contains links that are not reproducible herein. Exhibit B herein shows the contents of the "doclink" on page 2 of Exhibit D.

Amendment/Response

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It is my belief that one of ordinary skill in the art at the time of my invention could have built the invention based on my invention disclosure with no more than routine experimentation. The components were all off-the-shelf items, and configuring the hardware and software to complete the interfaces would not have required any sort of major research effort.

I received an e-mail on March 21, 2001 (Exhibit C) from IBM's Japan Intellectual Property Department which indicated some confusion as to where I was physically located, because my permanent assignment was in the U.S. and my assignment to China was only temporary.

I met with other IBM employees in Hong Kong on May 23, 2001 to evaluate my invention.

The evaluation review team's recommendation on May 28, 2001 was to have a patentability search conducted. See Exhibit D, page 7.

The final decision to prepare and file the patent application was made on September 4, 2001. See Exhibit D, page 7. I believe that an outside counsel was tasked with drafting the patent application, but I don't remember who it was or where they were located. I worked with the patent attorney to provide additional details for the application over the next several months. I did not save any copies of the draft applications that were sent back and forth between me and the patent attorney.

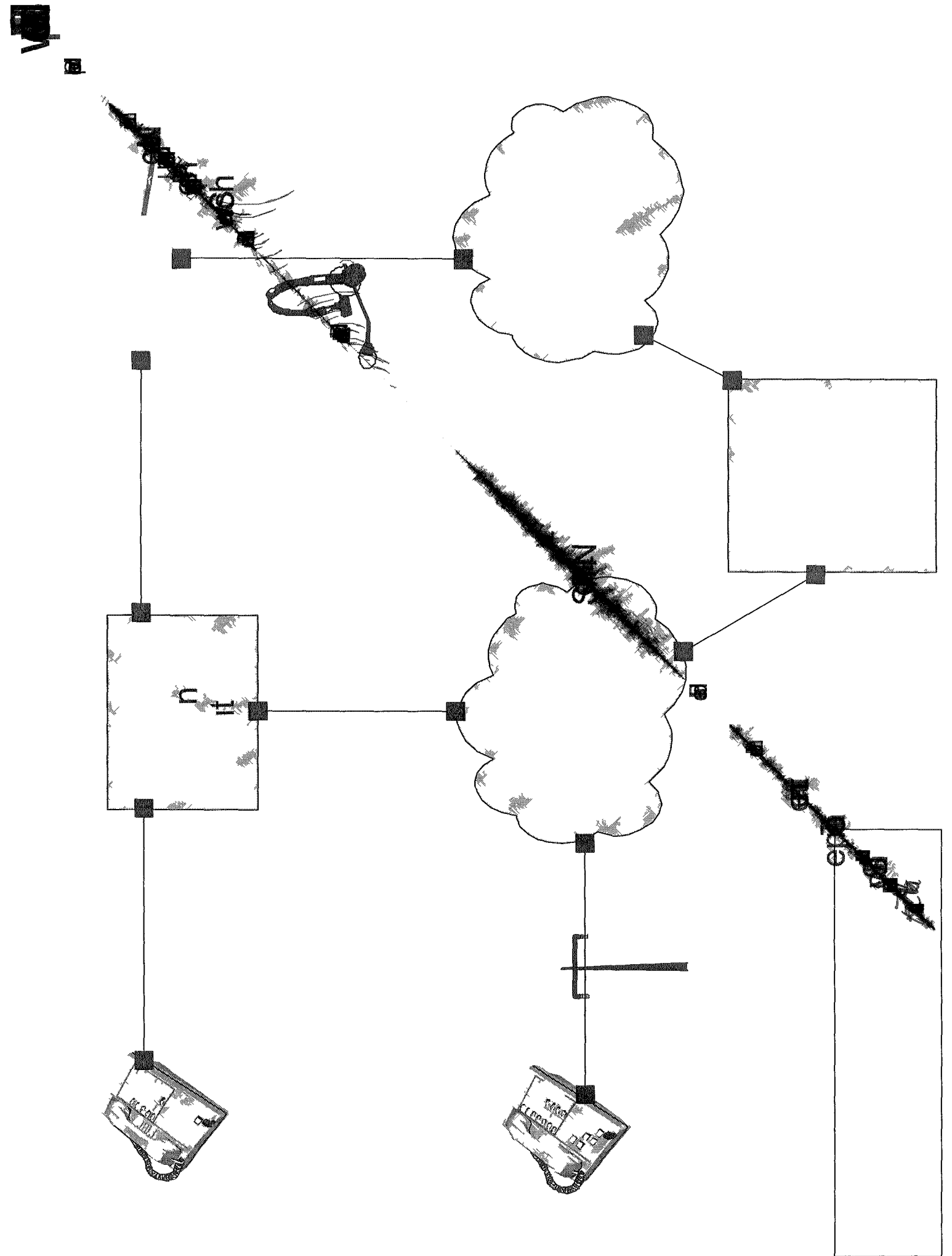
I received a final draft of the patent application on January 15, 2002 for my review.

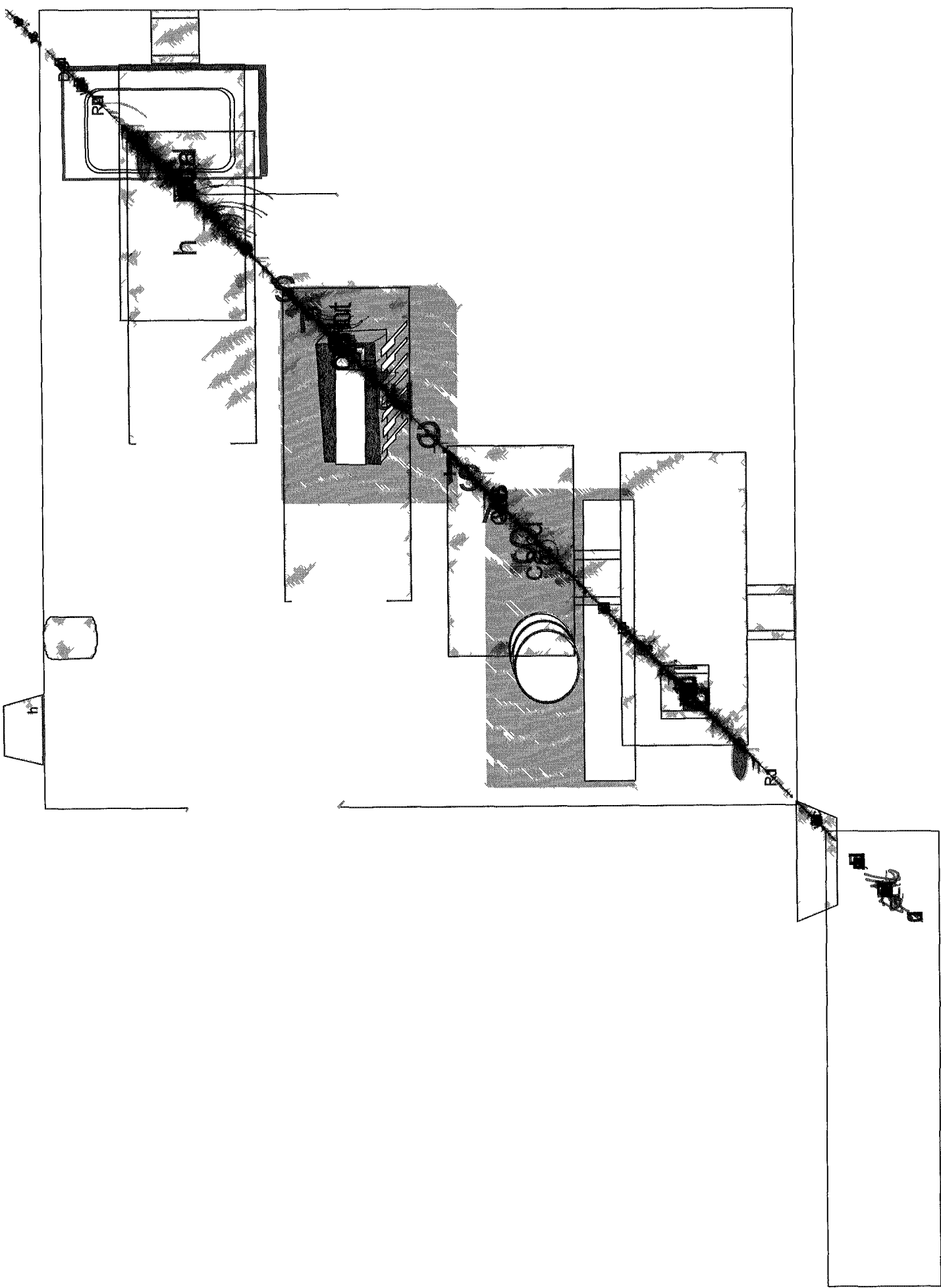
The patent application was filed on February 13, 2002.

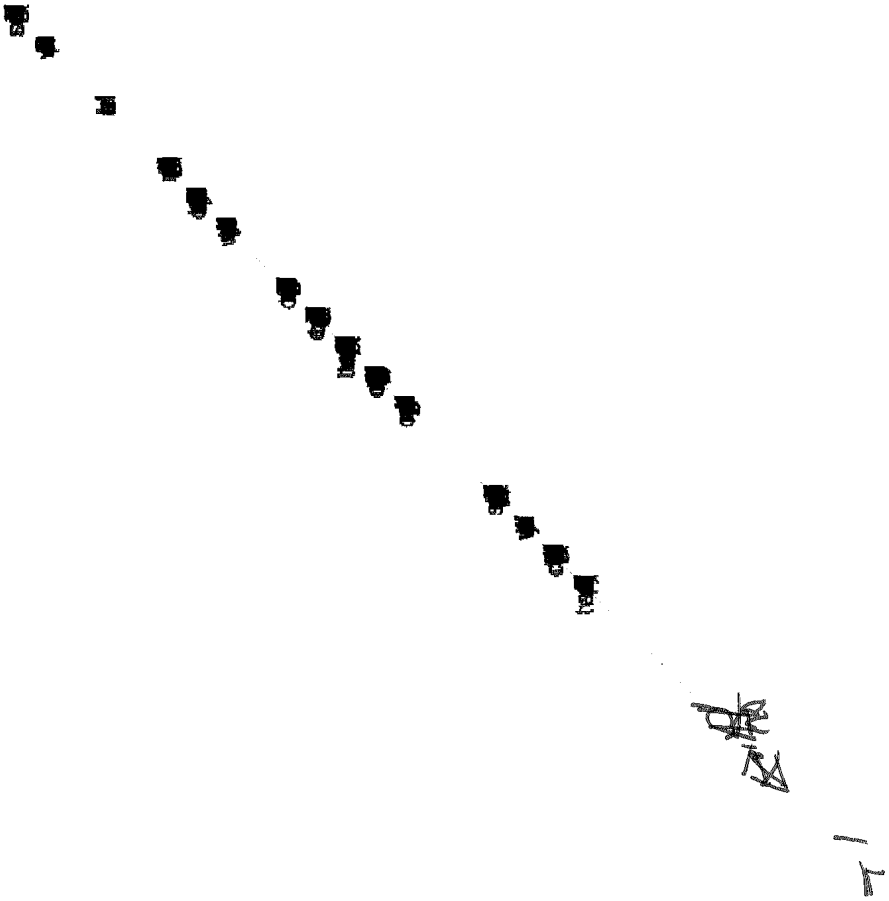
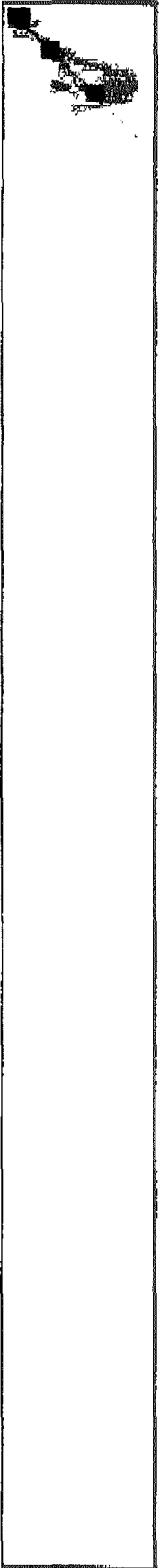
Respectfully submitted,

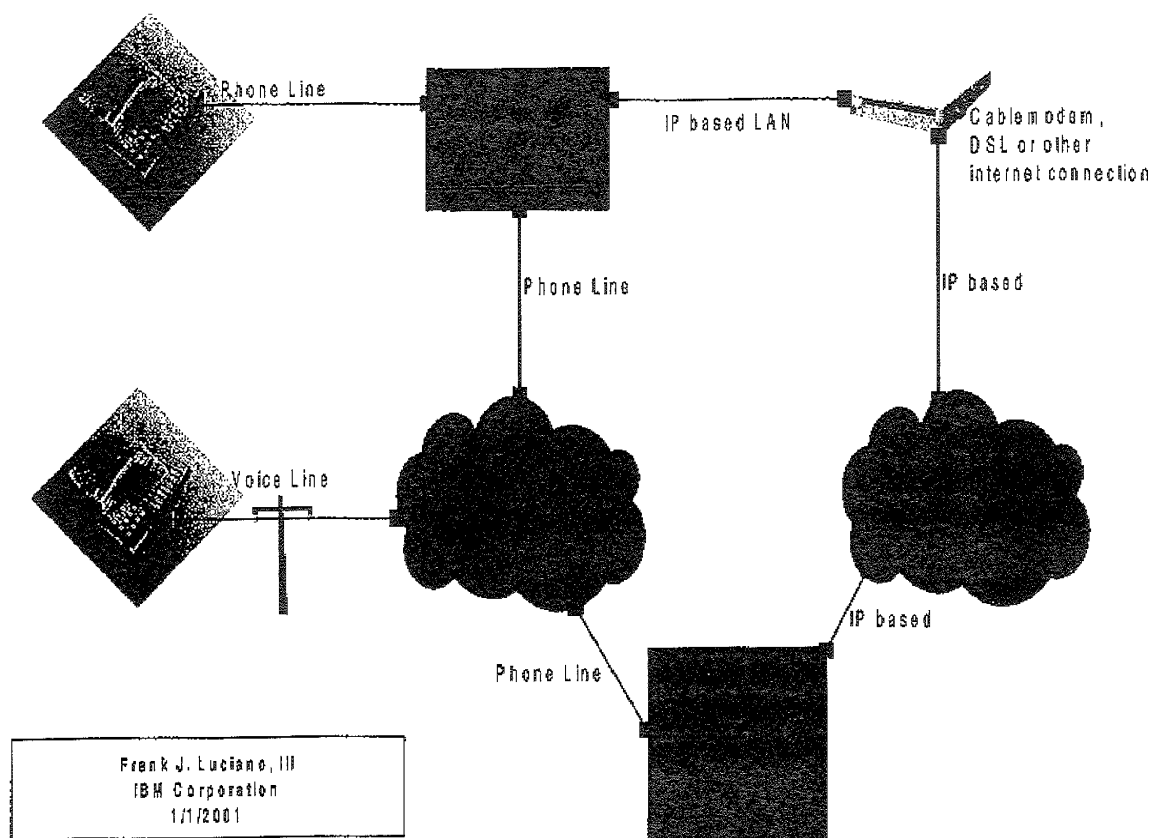
A handwritten signature in dark ink, appearing to read "Frank J. Luciano III", written over a horizontal line.

Frank J. Luciano III
Inventor and Declarant

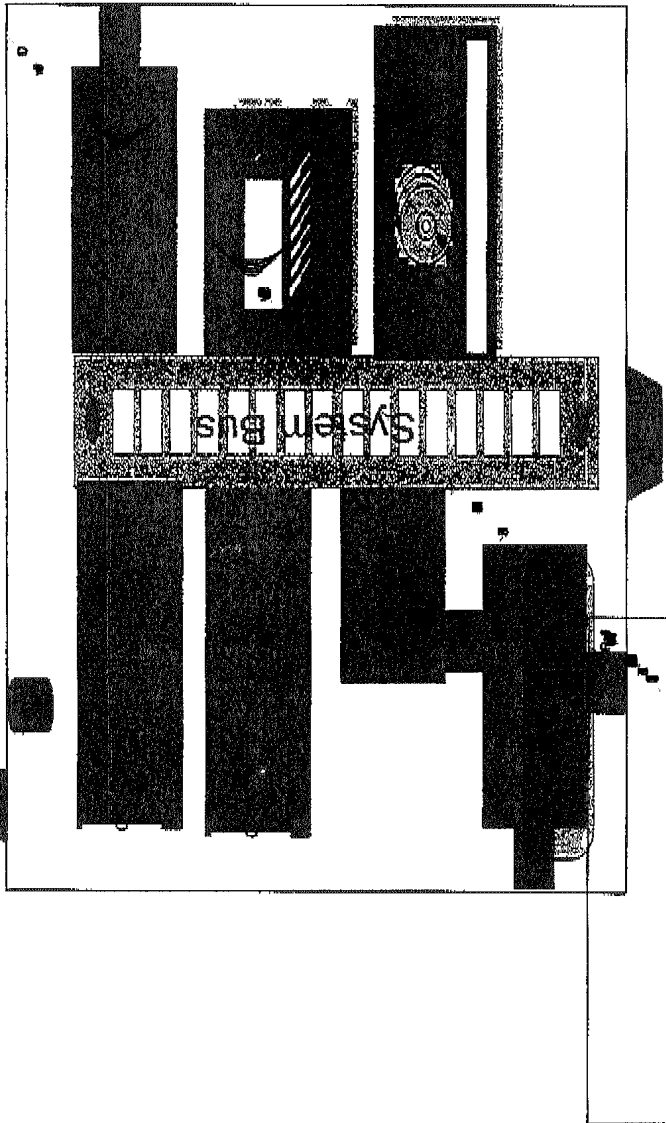




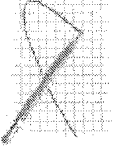




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* * * * *
TOT PAGE. 10 * * *

 Kohtaroh
Tanaka@IBMJP

To: FRANK LUCIANO/Waltham/IBM@IBMUS
cc: Frank LUCIANO/China/IBM@IBM CN
From: Kohtaroh Tanaka/Japan/IBM@IBMJP
Subject: *IBM Confidential: Invention Disclosure (Net-aware Telephone Switch)

03/21/2001 01:44 AM

This document expires on
03/20/2003

Luciano-san,

I, Japan-IPD (Intellectual Property Dept.) have received your invention disclosure titled "Net-aware Telephone Switch". I handle invention disclosures from GCG (Greater China Group) Global Services. You, however, do not appear to belong to GCG Global Services in view of your Notes ID, FRANK LUCIANO/Waltham/IBM@IBMUS. I'm wondering how this invention was made or conceived.

So I'd like to confirm a few points on this invention. Would you please answer me the following questions at once?

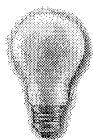
When and where was this invention made or conceived? During your own work in US? Or during your assignment in GCG like Hong Kong or China?

Your quick response will be much appreciated. Thank you.

Best Regards,

Kohtaroh Tanaka
Japan Intellectual Property Dept. IBM Japan Ltd. LAB-A85
1623-14, Shimotsuruma, Yamato-shi Kanagawa-ken 242-8502, Japan
Internet: ktanaka@jp.ibm.com
TEL: 81-46-215-3352 FAX: 81-46-275-5296

Exhibit C



Disclosure JP8-2001-0228

Prepared for and/or by an IBM Attorney - IBM Confidential

Created By FRANK LUCIANO On 01/15/2001 04:24:28 AM EST
Last Modified By Su Sha Zhang On 11/15/2002 01:48:52 PM ZE9

Required fields are marked with the asterisk(*) and must be filled in to complete the form.

*Title of disclosure (in English)

Net-aware Telephone Switch

Summ...

Status	Final Decision (File)
Docket Family	CN9-2001-0005
Original Location	CN, JP
*Processing Location	China
*Functional Area	China - Global Services
Attorney/Patent Professional	Kohtaroh Tanaka/Japan/IBM
IDT Team	Masafumi Takeda/Japan/IBM Hiroshi Sakaguchi/Japan/IBM Barry YF YEUNG/Hong Kong/IBM Robert Aret/Australia/IBM Kiyoshi Matsubara/Japan/IBM EDWARD KELLEY/Fishkill/IBM Barry Lyon/Australia/IBM Sook Mei Yuen/Singapore/IBM Percy TK NG/Hong Kong/IBM Foa Daniel/China/IBM
Submitted Date	01/15/2001 04:43:00 AM EST
*Owning Division	SWG
Lab	
*Technology Code	

Exhibit D

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PVT Score

35

Inventors with a Blue Pages en..

Inventors: FRANK LUCIANO/Waltham/IBM


Inventor Name	Inventor Serial	Div/Dept	Inventor Phone	Manager Name
Luciano, III, F. J. (Frank)	152974	05/MCDE	362-2874	Nile, S.C. (Susan)

> denotes primary contact

Inventors without a Blue Pages en..**IDT Selec...**

Attorney/Patent Professional	Kohtaroh Tanaka/Japan/IBM
IDT Team	Masafumi Takeda/Japan/IBM
	Hiroshi Sakaguchi/Japan/IBM
	Barry YF YEUNG/Hong Kong/IBM
	Robert Aret/Australia/IBM
	Kiyoshi Matsubara/Japan/IBM
	EDWARD KELLEY/Fishkill/IBM
	Barry Lyon/Australia/IBM
	Sook Mei Yuen/Singapore/IBM
	Percy TK NG/Hong Kong/IBM
	Foa Daniel/China/IBM@IBMCN
Response Due to IP&L	04/21/2001

***Main I...**

To view the main idea for this disclosure, click on this doclink --->  (If you are prompted to enter a server name, please enter D01D)

Critical Questions (Questions 1-9 must be answered in Engli...**Question 1**

On what date was the invention workable? 01/01/2001 Please format the date as MM/DD/YYYY
(Workable means i.e. when you know that your design will solve the problem)

***Question 2**

Is there any planned or actual publication or disclosure of your invention to anyone outside IBM?

☐ Yes
☒ No

If yes, Enter the name of each publication or patent and the date published below

Publication/Patent:

Date Published or Issued:

Are you aware of any publications, products or patents that relate to this invention?

☐ Yes
☒ No

If yes, Enter the name of each publication or patent and the date published below

Publication/Patent:

Date Published or Issued:

***Question 3**

Has the subject matter of the invention or a product incorporating the invention been sold, used internally in manufacturing, announced for sale, or included in a proposal?

☐ Yes
☒ No

Is a sale, use in manufacturing, product announcement, or proposal planned?

☐ Yes
☒ No

If Yes, identify the product if known and indicate the date or planned date of sale, announcements, or proposal and to whom the proposal has been or will be made.

Product:

Version/Release:

Code Name:

Date:

To Whom:

If more than one, use cut and paste and append as necessary in the field provided

***Question 4**

Was the subject matter of your invention or a product incorporating your invention used in public e.g., outside IBM or in the presence of non-IBMers?

☐ Yes
☒ No

If yes, give a date. Please format the date as MM/DD/YYYY

***Question 5**

Have you ever discussed your invention with others not employed at IBM?

☐ Yes
☒ No

If yes, identify individuals and date discussed. Fill in the text area with the following information, the names of the individual:

under CDA, and CDA #.

***Question 6**

Was the invention, in any way, started or developed under a government contract or project?

☐ Yes
☒ No
☐ No

If Yes, enter the contract number

***Question 7**

Was the invention made in the course of any alliance, joint development or other contract activities?

☐ Yes
☒ No
☐ No

If Yes, enter the following:

Name of Alliance, Contractor or Joint Developer

Contract ID number

Relationship contact name

Relationship contact E-mail

Relationship contact phone

***Question 8**

Have you, or any of the other inventors, submitted this same invention disclosure or similar invention disclosure previously?

☐ Yes
☒ No
☐ No

If Yes, please provide disclosure number below:

***Question 9**

Are you, or any of the other inventors, aware of any related inventions disclosures submitted by anyone in IBM previously?

☐ Yes
☒ No
☐ No

If Yes, please provide the docket or disclosure number or any other identifying information below

Question 10

What type of companies do you expect to compete with inventions of this type? *Check all that apply.*

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- ☐ Manufacturers of enterprise servers
- ☒ Manufacturers of entry servers
- ☐ Manufacturers of workstations
- ☒ Manufacturers of PC's
- ☒ Non-computer manufacturers
- ☒ Developers of operating systems
- ☒ Developers of networking software
- ☒ Developers of application software
- ☐ Integrated solution providers
- ☐ Service providers
- ☐ Other (Please specify below)

Question 11

If the invention relates to a product or service that is outside the scope of your business unit, please recommend IBM business individual(s) within IBM that you think would provide a good evaluation of your invention:

IBM pervasive computing Group

***Patent Value Tool (Optional - this may be used by the inventor and attorney to assist with the evaluation)**

(The Patent Value tool can be used by the inventor(s) to determine the potential licensing value of your invention)

Market

***Question 1:** What is the anticipated annual market size (in dollars) that will be captured by your invention?

\$100M to \$1B

Reason(s) for above Answer: 10% of US homes with PC at \$100/device

$\$100 \times (34,000,000) \times .5 \times .1$

Claims

***Question 1:** How new is the technical field?

Emerging

Reason(s) for above Answer: These type of internet home devices was the newest wave of technology

***Question 2:** How central is the invention to the product(s) which might be expected to contain the invention?

Entire Product

Reason(s) for above Answer: these is the entire solution

***Question 3: What is the scope of the claim?**

Fundamental

Reason(s) for above Answer: I don't know what this means.

Portfolio Need

***Question 1: What are the portfolio needs in the area of your invention?**

Unlisted

Reason(s) for above Answer: what's this

Exploitation & Enforcement

***Question 1: How easily can the use of the invention by a competitor be detected?**

With work

Reason(s) for above Answer:

***Question 2: How easily can the use of the invention be avoided by a competitor?**

With work

Reason(s) for above Answer:

Business Value

***Question 1: What percentage of the companies producing products in the field of this invention might use this invention?**

Broadly cloned

Reason(s) for above Answer:

***Question 2: What is the value of this patent to current or anticipated Alliance Activity between IBM and other companies?**

High value

Reason(s) for above Answer:

***Question 3: What is the value of this patent to current or anticipated Technology Transfer Activity between IBM and other c**

High value

Reason(s) for above Answer:

***Question 4: Does it result in prestige to IBM?**

Industry wide

Reason(s) for above Answer:

Evaluate...

This evaluation was entered by **Kohtaroh Tanaka/Japan/IBM** on **05/28/2001**

Team Evaluation

What is the team's evaluation of this disclosure? Search

Date rated : 05/28/2001

Evaluation Comments

Final Evaluation History

Search

Who made the final evaluation

Kohtaroh Tanaka/Japan/IBM

Final evaluation date

2001/05/28

Search Informa...

Date sent:

*Target completion date:

Search Results Received d

Who was the search sent to (This area is to designate a Local Searcher name or WA IPL):

*Search Type: ☐ Patentability ☐ Clearance ☐ Validity ☐ State of Art

*Features to be searched:

Search Office Informa...

Target completion date:

☐ Search has been delayed

Ship/Return date:

Search Conducted By

Comments

Final Deci...

This decision was entered by **Miki Aridome/Japan/IBM** on **09/04/2001**

Decision: File

PPM Area: 700 - Network Computing

Actual Release Date:

Date of Final Decision : 09/04/2001

Status: N/A

Attorney Rating: 2

Additional filing information

Planned Filing date:

Filing comments:

Additional decision comments

Final Decison History

Entered on 4-Sep-2001 by Miki Aridome

File N/A 4-Sep-2001 Docket Family: CN920010005

Post Disclosure Text & Drawi...

To add additional information related to this disclosure once it has been submitted, click the action button below and a new docur enter the new information. To view existing post disclosure information, double-click on the item in the list below (if there has l entered), and the document will open for you to view.

Date entered Post disclosure information (comments and drawings)

Form Revised 09/01/02)

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